



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,172	01/16/2002	Satoshi Inami	2002-0022A	2339

513 7590 09/07/2005

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
----------	--------------

2165

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,172

Applicant(s)

INAMI ET AL

Examiner

Sam Rimell

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Art Unit: 2165

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 15: Claim 15 has been amended to refer to “a transmission data determining unit for determining, among the generated data stored in the generated data storage unit, the transmission data to be transmitted...”.

The original disclosure only contains one single mention of a “transmission data determining unit” (page 5, last paragraph of specification), and describes its functions as follows:

“a transmission data determining unit for determining, based on transmission information specifying data, the transmission data to be transmitted..”

The original disclosure does not state that the transmission data determining unit makes its determination from amongst generated data stored in a generated data storing unit. There is no other discussion in the disclosure of a “transmission data determining unit”, except for what is quoted herein.

Accordingly, the quotation cited above from claim 15 is new matter, as it describes features that were not originally disclosed.

Claims 16-20: Depend on claim 15.

Claim 21: Claim 21 has been amended to refer to “storing the data generated due to execution of the application” and “determining, from amongst the stored generated data, the transmission data to be transmitted to the server based on said transmission information specifying data;”

The original disclosure makes its closest reference to this concept at page 26, last paragraph, where it states:

“The transmission data generating unit then determines the transmission data amongst the generated data (step S82).”

The original disclosure further states (page 19, paragraph 0051):

“The application executing unit 42 is realized by the CPU 11 and RAM 12 that execute the application 131. Here, data generated by the application executing unit is called generated data.”

The original disclosure does not state that determination is made from amongst the stored generated data, where the data is derived from the execution of the application. Instead it states that the determination is made from amongst data generated by the application executing unit, which is not the data generated by the application itself.

Accordingly, the determining step quoted from claim 21 above is new matter, as it describes features that were not originally disclosed.

Claims 22-26: Depend on claim 21.

Claim 27: Same rationale as set forth for claim 15.

Claims 28-30: Depend on claim 27.

Claim 31: Same rationale as for claim 21.

Art Unit: 2165

Claims 32-34: Depend on claim 31.

Remarks

Applicant's arguments are moot in light of the new grounds of rejection.

This action follows the filing of an RCE request and is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.



Sam Rimell
Primary Examiner
Art Unit 2165